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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/593,668	05/01/2007	Neil Buxton	3711-000121/US/NP	2798
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HARNESS, DICKEY & PIERCE, P.L.C. P.O. BOX 828 BLOOMFIELD HILLS, MI 48303			EXAMINER ROCHE, JOHN B	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/593,668	Applicant(s) BUXTON ET AL.	
	Examiner JOHN B. ROCHE	Art Unit 2184	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 April 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/14/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3-7, 9-13 and 15-18 are rejected under 35 U.S.C. 102(b) as being anticipated by "Microsoft Device Driver for Symbios Logic ATA/ATAPI-to-1394 Controller Included in Microsoft's New NT5 Beta DDK Release, 10/6/1997," hereafter referred to as Microsoft'997.

3. Referring to claim 7, Microsoft'997 anticipates a host apparatus arranged to transmit commands to an external storage medium device connected to the host apparatus over an external databus which is arranged in accordance with one of the IEEE 1394 standard and the Universal Serial Bus standard, the host apparatus comprising: a command bus and a command interface arranged in accordance with one of the ATA/IDE standard and the Serial ATA standard for transmitting commands to a storage medium device over the command bus (ATA commands transmitted through 1394-to-ATA

bridge via SBP-2 protocol, paragraph 3, lines 2-5); and at least one integrated circuit chip connected to the command bus and having terminals for connection to the external databus (SYM13FW500 ATA/ATAPI-to-1394 controller, paragraph 1, line 1), the integrated circuit chip having an interface arranged to convert commands received from the command bus in a format in accordance with one of the ATA/IDE standard and the Serial ATA standard into a format in accordance with said one of the IEEE 1394 standard and the Universal Serial Bus standard (1394-to-ATA bridge, paragraph 3, line 5), and to supply the converted commands to the terminals for connection to the external databus (controller contains capability for an external PHY, paragraph 4, lines 6-7).

4. Note that claims 1 and 13 contain the corresponding limitations of claim 7 as shown above; therefore, they are rejected using the same reasoning accordingly.

5. As to claim 9, Microsoft'997 anticipates a host apparatus according to claim 7, wherein said one of the ATA/IDE standard and the Serial ATA standard is the ATA/IDE standard (ATA device, paragraph 3, line 4).

6. Note that claims 3 and 15 contain the corresponding limitations of claim 9 as shown above; therefore, they are

rejected using the same reasoning accordingly.

7. As to claim 10, Microsoft'997 anticipates a host apparatus according to claim 7, wherein said one of the IEEE 1394 standard and the Universal Serial Bus standard is the IEEE 1394 standard (1394 command sets, paragraph 3, lines 2-3).

8. Note that claims 4 and 16 contain the corresponding limitations of claim 10 as shown above; therefore, they are rejected using the same reasoning accordingly.

9. As to claim 11, Microsoft'997 anticipates a host apparatus according to claim 10, wherein said one of the IEEE 1394 standard and the Universal Serial Bus standard is the IEEE 1394 standard including a Serial Bus Protocol (SBP-2, paragraph 3, line 1).

10. Note that claims 5 and 17 contain the corresponding limitations of claim 11 as shown above; therefore, they are rejected using the same reasoning accordingly.

11. As to claim 12, Microsoft'997 anticipates a host apparatus according to claim 7, wherein the interface of the integrated circuit chip comprises: a first layer arranged in accordance with said one of the ATA/IDE

standard and the Serial ATA standard to receive commands from the command bus (ATA device, paragraph 3, line 4); a second layer arranged to convert commands output from the first layer into a format in accordance with said one of the IEEE 1394 standard and the Universal Serial Bus standard (1394-to-ATA bridge, paragraph 3, line 5); and a third layer arranged in accordance with said one of the IEEE 1394 standard and the Universal Serial Bus standard to transmit the converted commands over the external databus (SBP-2 protocol embedded in the controller, paragraph 3, lines 1-2).

12. Note that claims 6 and 18 contain the corresponding limitations of claim 12 as shown above; therefore, they are rejected using the same reasoning accordingly.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 2, 8 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft'997 in view of Hatano (US 2002/0002645), hereafter referred to as Hatano'645.

15. As to claim 8, Microsoft'997 does not appear to explicitly teach a host apparatus according to claim 7, wherein the host apparatus is a digital television receiver apparatus.

16. Hatano'645 teaches the host apparatus according to claim 7, wherein the host apparatus is a digital television receiver apparatus (1394 bus may couple a digital broadcast receiving device and a digital television, paragraph 5, lines 5-7).

17. It would have been obvious to one of ordinary skill in the art at the time of invention to modify Jacobs'788's system to incorporate, as taught by Hatano'645, the host apparatus according to claim 7, wherein the host apparatus is a digital television receiver apparatus. The motivation to combine these teachings is to provide reliable communication and control among electronic devices coupled through different types of interfaces (paragraph 15, lines 1-4).

18. Note that claims 2 and 14 contain the corresponding limitations of claim 8 as shown above; therefore, they are rejected using the same reasoning accordingly.

Response to Arguments

19. Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.

20. Applicant's arguments, see page 1, lines 1-6, filed 10 April 2009, with respect to the drawings have been fully considered and are persuasive. The objection of the drawings has been withdrawn.

21. As to claims 1, 7 and 13, Examiner respectfully submits that Microsoft'997 anticipates the matter of these claims, as shown above.

Conclusion

22. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 14 April 2009 prompted the new ground(s) of rejection presented in this Office action. Accordingly,

THIS ACTION IS MADE FINAL. See MPEP § 609.04(b).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN B. ROCHE whose telephone number is (571)270-1721. The examiner can normally be reached on 8:30 am - 5:00 pm, M-F EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Tsai can be reached on 571-272-4176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JR

**/Henry W.H. Tsai/
Supervisory Patent Examiner, Art Unit 2184**